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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION N
10/665,139	09/17/2003	John M. Beville	PTG 02-103-8	5799
23531	7590	10/04/2004	EXAMINER	
SUITER WEST PC LLO 14301 FNB PARKWAY SUITE 220 OMAHA, NE 68154			LOPEZ, MICHELLE	
			ART UNIT	PAPER NUMBER
			3721	

DATE MAILED: 10/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/665,139	Applicant(s) BEVILLE ET AL.	
	Examiner Michelle Lopez	Art Unit 3721	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 30-38 is/are pending in the application.
- 4a) Of the above claim(s) 12-29 and 39-45 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 30-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/20/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group I, claims 1-11 and 30-38, in the reply filed on September 20, 2004 is acknowledged.
2. Claims 12-29 and 39-45 withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on September 20, 2004.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the features of a "universal adapter assembly" and a "pick-off pivot assembly" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement

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Sheet” in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 7, it is not clear what is the “pick-off pivot assembly”?

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. Claims 1-4, 11, 30-32, and 38 are rejected under 35 U.S.C. 102(a) as being anticipated by Shkolnikov (US 6,739,490). Shkolnikov’490 discloses a pivoting probe assembly “50” for engaging a nail advancing within a nail loading assembly “36” wherein the pivoting probe assembly “50” interfere with the progress of the nails being fed through the magazine “36”; a

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pivoting probe base assembly via "54" coupled with the pivoting probe assembly "50" for enabling rotation of the pivoting probe assembly "50"; a base assembly "56" coupled with the pivoting probe base assembly "54" and the nail loading assembly "36", the base assembly "56" for enabling rotation of the pivoting probe base assembly "54"; a lock ledge assembly at the vicinity of "64" coupled with the base assembly "56" via "62", the lock ledge assembly being suitable for providing a stop by engaging with the pivoting probe assembly "50" via "62"; a first probe "52"; a second probe "60"; a first tensioning assembly via a ring spring (not shown numerically) at the vicinity of "54" (see Fig. 5); a second tensioning assembly via a strip of spring steel (not shown numerically) at the vicinity of "64" (see col. 5; lines 43-53); a combustion nail gun (see Fig. 1) and further a motor driven nail gun wherein a fan motor "12" is being powered by a battery "42"; a clutch assembly via nosepiece "26".

Insofar claim 2 was understood, since Shkolnikov's probe assembly "50" is pivotally coupled to the nail loading assembly "36", wherein the base assembly or pivot ring "56" surrounding the pivoting probe base assembly via pin "54" provides a point about which the lever arm "52" freely rotates, it is deemed that an angle of engagement is provided at the pivot point by "54".

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 5-8, 10, 33-35, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shkolnikov (US 6,739,490) in view of Chen (US 6,431,428). Shkolnikov'490 discloses the invention substantially as claimed except for an adjustable angle magazine. However, Chen'428 teaches an adjustable angle magazine for the purpose of rotating and positioning the magazine to a desired angle relative to the nail gun driving mechanism (see Abstract). In view of Chen'428, it would have been obvious to one having ordinary skills in the art to have provided Shkolnikov's invention with an adjustable angle magazine in order to rotate and position the magazine to a desired angle relative to the nail gun driving mechanism, wherein the nail gun can accommodate different types of nails without changing to a different magazine.

With regards to claims 6 and 33, Shkolnikov'490 does not disclose a universal adapter assembly. However, Chen'428 teaches an adjustable angle magazine with a universal adapter assembly via the mounting bracket "22" for the purpose of coupling the adjustable angle magazine with a nail gun. In view of Chen'428, it would have been obvious to one having ordinary skills in the art to have provided Shkolnikov's invention with an adjustable angle magazine with a universal adapter assembly in order to couple the adjustable angle magazine with a nail gun.

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With regards to claims 7 and 34, Shkolnikov'490 does not disclose pick-off pivot assembly. However, as claim 7 was understood, Chen'428 teaches a pick-off pivot assembly via knob "23" for the purpose of coupling and securing the adjustable angle magazine with a nail gun at a desired angle. In view of Chen'428, it would have been obvious to one having ordinary skills in the art to have provided Shkolnikov's invention with a pick-off pivot assembly in order to couple and secure the adjustable angle magazine with a nail gun at a desired angle.

With regards to claims 8 and 35, Shkolnikov'490 does not disclose an articulating pusher assembly. However, Chen'428 teaches an articulating pusher assembly via "32" for the purpose of forwardly pushing the nails along a magazine feeding channel "202". In view of Chen'428, it would have been obvious to one having ordinary skills in the art to have provided Shkolnikov's invention with an articulating pusher assembly in order to forwardly push the nails along a magazine feeding channel.

With regards to claims 10 and 37, Shkolnikov'490 does not specifically disclose that the nail gun is a pneumatic nail gun. However, Chen'428 teaches a pneumatic nail gun (see Fig. 2) for the purpose of pneumatically powering and driving a nail fastening gun. In view of Chen'428, it would have been obvious to one having ordinary skills in the art to have provided Shkolnikov's invention with a pneumatic nail gun in order to pneumatically powering and driving a nail fastening gun.

With regards to claims 10 and 37, Shkolnikov'490 does not specifically disclose that the nail gun is a spring-loaded nail gun and an electromagnetic nail gun. However, it would have been an obvious matter of design choice to have provided a nail gun consisting from a spring-loaded nail gun and an electromagnetic nail gun, since applicant has not disclosed that a spring-

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loaded nail gun and an electromagnetic nail gun solves any stated problem or is for any particular purpose and it appears that Shkolnikov's invention would perform equally well with a combustion nail gun for the purpose of properly powering a nail gun.

7. Claims 9 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shkolnikov'490 as applied to claims 5 and 30 above, and further in view of Wohlwend (US 6,685,078). Shkolnikov'490 as modified by Chen'428 does not disclose that the magazine is a top load magazine. However, Wohlwend'078 teaches a top load magazine via "3" (see Figs. 2 and 3) for the purpose of providing a magazine that can be easily feed by both a right and a left handler operator without decoupling the magazine from the nail gun. In view of Wohlwend'078, it would have been obvious to one having ordinary skills in the art to have provided Shkolnikov'490 as modified by Chen'428 and further with a top load magazine in order to provide a magazine that can be easily feed by both a right and a left handler operator without decoupling the magazine from the nail gun.

Conclusion

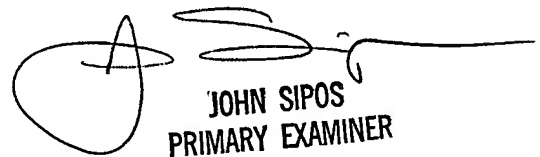
8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kaneko'161, Moorman'975, Dohi'899, Akiba'737, Hamano'022, Amada'572, Osuga'861, Thieleke'860, Yao'524, and Canlas'718 are cited to show related inventions.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michelle Lopez whose telephone number is 703-305-8205. The examiner can normally be reached on Monday - Thursday: 8:00 am - 6:00 pm.

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10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ML



JOHN SIPOS
PRIMARY EXAMINER